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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,446	01/28/2004	Douglas G. Vanderlaan	VTN5537DIV	3191

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,446

Applicant(s)

VANDERLAAN ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/28/04 Preliminary amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 75-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 18-23 and 75-78 is/are rejected.
- 7) ☒ Claim(s) 1-23 and 75-80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' preliminary amendment filed on January 28, 2004 was received. Claims 1, 12-23 and 75 are amended. Now, Claims 1-23 and 75-80 are pending.
2. Applicant is advised that should Claims 1, 9 and 10-11 be found allowable, Claims 75-78, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

3. Claims 1-23 and 75-80 are objected to because of the following informalities:

In Claim 1 (line 3), Claim 18 (line 3), Claim 21 (line 2), and Claim 75 (line 3), should "polydimethylsiloxane" be -- polydiorganosiloxane -- because the substituents, R₅₉ and R₆₁, in the structures described in Claims 1 and 75 are not necessarily methyl groups?

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4. Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A Young's modulus of about 30-160 psi does not further limit the subject matter of Claims 12-13.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-8, 18-23 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-8 and 18-23 recite the limitation "reactive monomer" in Claims 6-8, 18 and 76 (line 2). There is insufficient antecedent basis for this limitation in the claim.

Claim 76 recites the limitation "claim 1" in Claim 76 (line 2). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-11 and 75-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Spinelli (US 5 314 960).

Spinelli discloses a method for preparing silicone hydrogel derived from monomers including the (meth)acryl-containing silicone monomer described in Figures 1A-1C, col. 7, lines 18-37. (col. 6, line 3 to col. 9, line 68 and Examples) Note that “lowering the Young’s modulus or $\tan \delta$ ” is an inherent outcome due to the incorporation of the instant (meth)acryl-containing silicone monomer. For Claims 9-11 and 76-78, Spinelli further teaches the use of a mixture of TRIS and

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other (meth)acryl-containing silicone monomers such as n-pentylhexamethyltrisiloxanylmethylmethacrylate, etc. (col. 17, lines 4-41)

9. Claims 12-23 and 79-80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Spinelli does not teach a method which lowers the Young's modulus or $\tan \delta$ to the specific range set forth in the instant claims. Especially, it is noted that the specific ranges of the Young's modulus and $\tan \delta$ are not inherent properties of any composition that is derived from a monomer mixture comprising the aforementioned (meth)acryl-containing silicone monomer. The Young's modulus and $\tan \delta$ depend on the relative amounts and characteristics of other monomers too. Furthermore, Spinelli does not even recognize the importance of Young's modulus or $\tan \delta$. Therefore, there is no motivation for one of ordinary skill in the art to optimize the Young's modulus or $\tan \delta$ based on the Spinelli's teaching. In light of which, Spinelli does not fairly suggest the specific ranges of the Young's modulus and $\tan \delta$ set forth in the present invention.


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
January 3, 2004


KUO-LIANG PENG
PRIMARY EXAMINER

Kuo-Liang Peng
Primary Examiner
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